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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,769	11/05/2003	Hans-Ulrich Stauber	P56988	6343

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EXAMINER
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MACKEY, PATRICK HEWEY

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/700,769

**Applicant(s)**

STAUBER, HANS-ULRICH

**Examiner**

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006 and 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 and 05 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/24/06 has been entered.

### ***Drawings***

2. The proposed drawing filed 4/24/06 has not been accepted by the examiner because it illustrates new matter. Specifically, the location of stations 90, 92, 94, 96, 98, 100, and 102 in relation to the conveyor is new matter.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bending elements integrated with the second rests, binding station, adhesion stations, and collection stations must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The specification is objected to because it references a Figure 8 which is not currently in the drawings.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 17-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 17 recites the limitation "a conveyor assembly selectively alignable spaced-apart from an end of the collection drum". There is no support for this limitation in the disclosure as filed. Claim 19 recites the limitation "a conveyor assembly positionably spaced-apart from said terminal portion to rotate around a second axis displaceable from coaxial alignment with said drum axis". There is no support for this limitation in the disclosure as filed.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-8 and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 5 and 6 appear to be duplicates of claims 7 and 8. Are the elements in claims 7 and 8 the same elements as in 5 and 6?
- b. Claim 6 recites the limitation "at least one rail". Is this the same rail as recited in claim 5?
- c. Claim 8 recites the limitation "at least one rail". Is this the same rail as recited in claim 7?
- d. Claims 11-15 recite the limitation "the conveyor means". There is insufficient antecedent basis for this limitation in the claim.
- e. Regarding claim 13, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 1, 2, 5-13, 17, 19, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller. Regarding claim 1, Muller discloses a collection drum (14) rotatably drivable about its drum axis (12) and comprised of first rests (18) with first saddles (20), the first rests being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), as well as conveyor elements (34) for conveying the printed products on the first saddles in the axial direction along the firsts rests; and comprising a conveyor device (40) which comprises a conveyor path (see Fig. 2) with a conveyor direction (u) which at least in a transfer region (50') deviates from the axial direction as well as second rests (42), movable in the conveyor path, with second saddles (52) arranged distanced to one another and arranged transversely to the conveying direction, wherein the conveyor device (40) in the transfer region is arranged adjacent to a collection drum end of the collection drum in a manner such that the printed products maybe transferred from the collection drum end to the conveyor device or vice versa (see col. 11, lines 5-7), wherein for the second rests movable in the conveyor path there is provided a conveyor unit (48) detached from the collection drum.

- a. Regarding claims 2 and 9, Muller discloses that the conveyor device (40) accommodates operating conditions with selected ones of binding stations, wire saddle stitching stations (82), adhering stations (74), and an additional collection station (90, 98) disposed to directly modify the printed products while the printed products are carried by the conveyor device on an upper side (see Figs. 5 and 7) of the conveyor device.
- b. Regarding claims 5 and 7, Muller discloses that the second rests (42) are movably supported on rails (72).

- c. Regarding claims 6 and 8, Muller discloses that the second rests (42) of a side opposite the second saddles (52) are supported on at least one rail (see col. 10, line 66 – col. 11, line 4).
- d. Regarding claim 10, Muller discloses that the second saddles (52) of the second rests (42) in the complete conveyor path (see Fig. 2) are movable in parallel with a predefined, equal distance to one another and conveyor devices (46') disposed to cooperate with the second rests (42) close to the saddle (52).
- e. Regarding claims 11 and 12, the working stations (74, 82, 90, 92, 94, 96, 98, 100, 102, 112, 28, 30, 88, 88', 88'') disclosed by Muller could possibly be allocated to the conveyor (40) means in an exchangeable sequence (see col. 9, lines 10-20).
- f. Regarding claim 15, the conveyor (40) means is designed as a revolving conveyor with an upper and a lower side with an essentially horizontal conveyor path (see Fig. 1).
- g. Regarding claim 16, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably drivable about a drum axis (12) and comprised of first rests (18) with first saddles (20), the first rests being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), as well as conveyor elements (34) for conveying the printed products on the first saddles in the axial direction along the firsts rests; and comprising a conveyor assembly (40) arranged adjacent to a collection drum end of the collection drum to accommodate transfer of the printed products between the collection drum end and the conveyor assembly, comprising a conveyor path (see Fig. 2) with a conveyor direction (u) deviating in a transfer region (50') from the axial

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direction, second rests (42), a conveyor unit (48) detached from the collection drum, disposed to propel the second rests along the conveyor path, and second saddles (52) arranged distanced apart from one another and arranged transversely to the conveying direction.

h. Regarding claim 17, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably driveable about a drum axis (12), the collection drum (14) comprising a terminal portion bearing first rests (18) with first saddles (20), the first rests (18) being uniformly distributed over a circumference and extending in longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), and conveyor elements (34) disposed to convey the printed products on the first saddles (20) in an axial direction along the firsts rests (18); and a conveyor assembly (40) selectively alignable spaced-apart (see col. 4, lines 50-57) from an end of the collection drum (14) to accommodate transfer of the printed products between the terminal portion and the conveyor assembly (40), the conveyor assembly (40) comprising a conveyor path with a conveyor direction (u) deviating in a transfer region (50') from the axial direction, second rests (42) bearing second saddles (52) arranged distanced apart from one another and arranged transversely to the conveying direction(u), a conveyor unit (48) detached from the collection drum and disposed to propel the second rests around a second axis radially displaceable from said drum axis and along the conveyor path.

i. Regarding claim 19, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably driveable about a



hub exhibiting a drum axis (12), the collection drum providing a terminal portion forming a transfer region (50'), the terminal portion comprising first rests (18) bearing first saddles (20), the first rests being uniformly distributed over a circumference and extending in longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), and conveyor elements (34) arrayed to convey the printed products on the first saddles (20) in an axial direction along the firsts rests (18); and a conveyor assembly (40) positionably spaced-apart from the terminal portion to rotate around a second axis displaceable from coaxial alignment (see col. 4, lines 50-57) with the drum axis to accommodate to within a transfer region (50') of the collection drum (14), transfer of printed products between the first rests (18) and a plurality of second rests (42) borne by the conveyor assembly (40) along a conveyor path deviating in the transfer region from the axial direction, by providing alignment (see col. 4, lines 50-57) between the first rests (18) and the second rests (42) within the transfer region (50'), the conveyor assembly (40) comprising a conveyor unit (40) detached from the collection drum and disposed to propel the second rests along the conveyor path.

j. Regarding claim 21, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably drivable about its drum axis and comprised of first rests (18) with first saddles (20), the first rests (18) being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), as well as conveyor elements (34) for conveying the printed products on the first saddles (20) in the axial direction along the firsts rests (18), and a conveyor device (40) comprising a revolving conveyer

(40) having an upper side and a lower side (see Fig. 7), a conveyor path with a conveyor direction (u) which at least in a transfer region deviates from the axial direction, second rests (42) movable in the conveyor path, and second saddles (52) arranged distanced to one another and arranged transversely to the conveying direction, with the conveyor device in the transfer region arranged adjacent to an end of the collection drum to enable carriage of the printed products to be transferred from an end to the conveyor device or vice versa (see col. 11, lines 5-7), and the second rests (42) being movable propelled along the conveyor path independently from the collection drum.

k. Regarding claim 22, Muller discloses at least one station (88'') positioned radially on an inside of the revolving conveyor (40), disposed to modify printed products carried by the revolving conveyor.

l. Regarding claim 23, Muller discloses a securement system (see col. 10, line 65 - col. 11, line 5) disposed along the lower side hindering printed products from escaping from carriage with the second rests (42).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller (US 5,562,278) in view of Mowry et al. (US 4,641,825). Muller discloses all the limitations of the claims, but it does not disclose bending elements integrated with the second rests. In fact,

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Muller does not disclose that the staples are bent at all. However, Mowry discloses a similar device that includes bending elements (72) integrated with rests (13) for the purpose of bending the staples provided by a stapling apparatus to prevent the staples from falling out of a bound printed product as is commonly known in the art. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to utilize bending elements integrated with the second rests, as disclosed by Mowry for the purpose of bending the staples provided by a stapling apparatus to prevent the staples from falling out of a bound printed product.

13. Claims 4, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller (US 5,562,278) in view of Hansch et al. (US 5,172,897). Muller discloses all the limitations of the claims, but it does not disclose that the stapling apparatus is movably mounted on a rail guided approximately parallel to the conveyor path. However, Hansch discloses a similar device that includes a stapling apparatus (28) that is movably mounted on a rail (26) guided approximately parallel to the conveyor path for the purpose of permanently assigning to a stapler head to each support allowing the stapling heads of a stapling head arrangement to be mutually offset in the longitudinal direction of the supports. It is thus possible, for example, for each second stapling head to be slightly offset in relation to the other stapling heads arranged in a plane. All the staples do not then come to be located above one another during stacking of the stapled sheets (see col. 15, lines 1-15). It would have been obvious for a person of ordinary skill in the art, at the time of the applicant's invention to modify Muller by utilizing a stapling apparatus that is movably mounted on a rail guided approximately parallel to the conveyor path, as disclosed by Hansch, for the purpose of permanently assigning to a stapler head to each

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support allowing the stapling heads of a stapling head arrangement to be mutually offset in the longitudinal direction of the supports. It is thus possible, for example, for each second stapling head to be slightly offset in relation to the other stapling heads arranged in a plane. All the staples do not then come to be located above one another during stacking of the stapled sheets.

***Response to Arguments***

14. Applicant's arguments filed 4/24/2006 have been fully considered but they are not persuasive.

15. The applicant states that Muller does not disclose each and every limitation in the independent claims. In response, see the rejection above.

16. The applicant states that Muller does not disclose a conveyor unit detached from the collection drum. In response, the examiner notes that Muller discloses a conveyor unit detached from the collection drum (see Muller item 48).

17. The applicant states that Muller does not disclose a transfer of printed products between the collection drum end and the conveyor assembly. In response, the examiner notes that Muller discloses a transfer of printed products between the collection drum end and the conveyor assembly (see at least Muller col. 4, lines 19-30).

18. The applicant states that Muller does not disclose a conveyor device that is arranged adjacent to a collection drum end of the collection drum. In response, the examiner notes that Muller discloses a conveyor device that is arranged adjacent to a collection drum end of the collection drum (see at least applicant's specification as filed, paragraph 0010).

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19. The applicant states that Muller does not disclose a collection drum. In response, the examiner notes that Muller discloses a collection drum (see at least applicant's specification as filed, paragraph 0010).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrick H. Mackey  
Primary Examiner  
Art Unit 3651

June 23, 2006